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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/950,902 10/15/97 HAGIWARA

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IM62/0713

| EXAMINER |
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SHERRER, C

| ART UNIT | PAPER NUMBER |
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1761

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DATE MAILED:

07/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/950,902

Applicant(s)
Haglwara

Examiner
Curtis E. Sherrer

Group Art Unit
1761



☒ Responsive to communication(s) filed on Jun 13, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-4 and 8-15 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 and 8-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Part III DETAILED ACTION

At the outset it is noted that Applicant has amended Claim 5, but Claim 5 was previously canceled (amendment of 06/04/99) and is no longer pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Papazian (The New Complete Joy of Home Brewing, pp. 95-99) for the reasons set forth in the last Office Action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-4, 8-10 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papazian in view of Rizzi et al (U.S. Pat. No. 5,008,125) for the reasons set forth in the last Office Action.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Papazian in view of Rizzi et al and in further view of Suzuki (U.S. Pat. No. 3,845,220) for the reasons set forth in the last Office Action.

Response to Arguments

6. Applicant's arguments filed 05/03/99 have been fully considered but they are not persuasive.

7. Again, Applicant argues that the Claim 8 is not anticipated by the disclosure of Papazian because the claimed product is produced by a process not contemplated by said disclosure. Applicant states that "the extraction residue is totally different from the coffee obtained from freshly ground beans. . ." but goes no further in stating what those differences might be. It is considered that the ground extract coffee residue will contain the same chemicals as found in non-extracted coffee, but in lower concentrations. There is nothing on the record to indicate otherwise. Therefore, the broad product claim is considered anticipated because it will contain the same chemicals as found and extracted by Applicant's process. Applicant's attention is again

directed to the holding in *In re Best*. Lastly, it is noted that the data found in the instant specification shows that the instant beverages have coffee color aroma and taste, as would a beverage made by the prior art method.

8. Applicant states that “using a uniquely different starting material, will necessarily be different.” No support for such an assertion is given. Further, it is considered that this is not necessarily true. For example, if one were to extract a pound of ground coffee using a gallon of cold water, the extract would contain some of the water soluble components of the ground coffee. If one were then to extract the remains of the one pound of ground coffee with only one cup of water, but heated, one would again obtain some of the water soluble components of the ground coffee. In other words, components that are derived from the first extraction are the same as that in the second extraction but only different in amount. The claims are not directed to amounts of coffee components nor how these components are obtained. Therefore, the coffee drink of Papazian would be the same drink as envisaged by the claims.

9. Applicant argues that the use of wine yeast versus beer yeast results in a different product because “a coffee wine is not a coffee beer” because “flavor, appearance, smell, are all differences between beers and wines.” Applicant supplies no substantive evidence for this assertion. It is noted that a notoriously well known product is “malt wine,” also sometimes known as “Imperial Stout,” that is produced using barley malt, hops, wine yeast or beer yeast, and water. Is it a beer or is it a wine? The answer is in the eye of the beholder.

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10. As to the whether Applicant's product is a wine or a beer, the answer is found in the disclosure of the specification. It is found therein, that any carbohydrate source, including simple glucose, not maltose or fruit juice, will produce a "coffee wine." Therefore, the answer is that the instant product is merely coffee mixed with a fermentable substrate that is then fermented. Again, the type of yeast will not produce a distinguishable product.

11. Applicant argues that Papazian does not teach adding a saccharide to the coffee residue extract before fermentation. It is unclear what specific point Applicant is arguing, i.e., that Papazian does not teach adding a saccharide, which he certainly does, or that he does not teach the addition of a saccharide in combination with a coffee extract residue. If it is the latter, this is admitted as true, but as stated previously, Papazian's final product will be the same.

12. Applicant then argues that the obviousness rejection is improper because Papazian would not want to use them. Applicant's reasoning is not well understood. Applicant argues that only a small proportion of spend coffee grounds would be used, i.e., about 20%. The only amounts of the residue claimed are in proportion to the amount of saccharide and this range is very broad so as to cover that which is disclosed.

13. Applicant states that no motivation has been supplied to support a *prima facie* case of obviousness. As referred to previously, Applicant's attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

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This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

The law applies to products as well as processes, i.e., "for treating them in ways which differ from the former practice."

14. Lastly, with respect to the rejection based in combination with Suzuki et al., Applicant argues that 'the function of the hydrolase treatment in the present invention is for a clearly different purpose than the enzyme treatment taught by Suzuki.' In response to Applicant's argument, the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

15. No claim is allowed.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached on (703)-308-0756. The **fax phone number** for this Group is (703)-305-3602.

18. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Curtis E. Sherrer', with a stylized, cursive script.

Curtis E. Sherrer
Primary Examiner
July 12, 2000